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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,726	03/19/2004	Terry A. Overby	CEL-128	2725
23508	7590	10/07/2005	EXAMINER	
LUNDEEN & DICKINSON, LLP PO BOX 131144 HOUSTON, TX 77219-1144			HOLLIDAY, JAIME MICHELE	
			ART UNIT	PAPER NUMBER
			2686	
DATE MAILED: 10/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/708,726	Applicant(s) OVERBY, TERRY A.	
	Examiner Jaime M. Holliday	Art Unit 2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-20, 23-25, 27 and 28 is/are allowed.
- 6) ☒ Claim(s) 7-12 and 14 is/are rejected.
- 7) ☒ Claim(s) 9, 13, 15-17, 20-22 and 26 is/are objected to.
- 8) ☒ Claim(s) 1-6 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/19/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. **Claims 1-6**, drawn to a universal provisioning system for radiotelephone handset units, classified in class 455, subclass 567.
 - II. **Claims 7-28**, drawn to a method for provisioning radiotelephone handset units, classified in class 455, subclass 419.
2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (II) as claimed does not require the particulars of the subcombination (I) as claimed because, for example, invention II does not require an interface with at least one universal connector. The subcombination (I) has separate utility such as to provide a universal provisioning system for handset units through a universal interface.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classifications, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Daniel Lundeen on September 27, 2005 a provisional election was made with traverse to prosecute the invention of **Group II, claims 7-28**. Affirmation of this election must be made by Applicant in replying to this Office Action. Claims 1-6 are withdrawn from further consideration by the Examiner, 37 C.F.R. 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on March 19, 2004 has been considered by the Examiner and made of record in the application file.

Specification

6. The disclosure is objected to because of the following informalities:

a) In **paragraph 39, line 7**, replace "(SDBA)" with --(SDBP)" --after "Database" in order to match the description of reference number 16 in figure 1;

b) In **paragraph 47, line 8**, replace "vendor"s" with --vendor's --after "a" in order to correct a typographical error;

c) In **paragraph 63, line 4**, omit --. -- after "invention." in order to correct a typographical error; and

d) In **paragraph 64, line 10**, insert --a-- after "not" in order to correct a grammatical error.

Appropriate correction is required.

Claim Objections

7. **Claims 9, 12 and 20** are objected to because of the following informalities:
- a) On **line 11 of claim 9**, replace “manufacturer”s” with --manufacturer’s-- after “handset” in order to correct a typographical error;
 - b) On **line 4 of claim 12**, replace “manufacturer”s” with --manufacturer’s-- after “handset” in order to correct a typographical error; and
 - c) On **line 11 of claim 20**, replace “manufacturer”s” with --manufacturer’s-- after “handset” in order to correct a typographical error.

Appropriate correction is required.

8. **Claims 15 and 26** are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Moles et al. (Pub # U.S. 2003/0162533 A1)** in view of **Carroll (U.S. Patent # 6,487,403 B2)**.

Consider **claim 7**, Moles et al. clearly show and disclose a service provisioning system for use in a wireless network comprising a provisioning controller **305** that operates under the control of provisioning server application program **315** to provide provisioning services for wireless network **100**, and creates MS **112** service provisioning file **330**, reading on the claimed "build request," in response to a provisioning request for the mobile station (MS). The service provisioning file comprises provisioning data used to configure the first mobile station to communicate with the wireless network. The service provisioning system further comprises a database capable of storing the service provisioning file, which further comprises a mobile station service provisioning program. The provisioning controller is further capable of retrieving the service provisioning file from the database and transmitting the service provisioning file

to the first mobile station. Memory **460**, in the mobile station, also stores downloaded service provisioning (prov.) file **470** and mobile station configuration data file **475**, reading on the claimed "automated method of provisioning radiotelephone handset units, comprising: generating a build request comprising a radiotelephone handset specification and provisioning and instruction data for the specified handset; storing the build request in a memory storage medium in communication with a computerized provisioning system; retrieving data from the build request; and, automatically transferring the provisioning data to memory storage of the connected handset in accordance with the instruction data," (abstract, figure 3, 4 and 5, paragraphs 19, 20, 57 and 67).

However, Moles et al. do not specifically disclose that the provisioning controller connects to the mobile station, reading on the claimed "handset," and that at the completion of the transmission of the service provisioning file, reading on the claimed "build request," the mobile station is disconnected from the service provisioning system.

In the same field of endeavor, Carroll clearly shows and discloses a system and method that efficiently and securely perform provisioning of cellular telephones and other wireless communication devices. System processing for provisioning a wireless device according to the present invention is carried out by a program executed by the computer **516**, but requires human intervention at some points; the WUPD **306** (Wireless Universal Provisioning Device) prompts a sales agent or operator to enter the type of device being provisioned. The sales

agent/operator targets the cellular telephone **308** to be activated. This can be done by aiming the antenna of the transceiver **514** to the cellular telephone, or by using a clip-on antenna to physically connect the WUPD's transceiver antenna to the cellular telephone's antenna, reading on the claimed "connecting the provisioning system to a handset in accordance with the build request specification," (figure 5 and 6, column 3 lines 62-64, column 6 line 53- column 7 line 4). After the WUPD transfers the necessary provisioning information to the target telephone using the telephone's air interface protocol, both the target cellular telephone and the WUPD indicate on their respective displays that the provisioning operation is complete after sending notification signals to each other, reading on the claimed "disconnecting the provisioned handset from the provisioning system," (figure 6, column 7 lines 28-30 and 44-48).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have to include the steps of targeting the cellular telephone to be provisioned, reading on the claimed "connecting the provisioning system to a handset," and indicating completion of the provisioning operation, reading on the claimed "disconnecting the provisioned handset from the provisioning system," as taught by Carroll in the system of Moles et al. in order to provide an efficient provisioning system for mobile stations.

12. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Moles et al. (Pub # U.S. 2003/0162533 A1)** in view of **Carroll (U.S. Patent # 6,487,403 B2)**, and in further view of **Piosenka et al. (U.S. Patent # 5,926,756)**.

Consider **claim 8**, and as applied to **claim 7** above, Moles et al., as modified by Carroll, clearly show and disclose the claimed invention except that the service provisioning file, reading on the claimed "build request," is generated and stored on a workstation networked to the provisioning system.

In the same field of endeavor, Piosenka et al. clearly show and disclose a method and system that programs a PED (programmable electronic device) such as a cellular telephone via the use of a personal computer. The present invention allows users of PEDs to use personal computers (PC's), which include the necessary operating system, processor, memory, display, keyboard and I/O ports necessary for the invention, to input data needed to program PEDs and means to load the PED programs into the PED, reading on the claimed "generating and storing are performed on a workstation networked with said computerized provisioning system," (abstract, column 2 lines 52-57 and column 3 lines 45-48).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to input data to program a cellular telephone, reading on the claimed "provisioning radiotelephone handset units," on a computer as taught by Piosenka et al. in the system of Moles et al. in order to provide an efficient provisioning system for mobile stations.

13. **Claims 9, 10, 11, 12 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Moles et al. (Pub # U.S. 2003/0162533 A1)** in view of **Carroll (U.S. Patent # 6,487,403 B2)**, and in further view of **Lipsit (U.S. Patent # 5,974,311)**.

Consider **claim 9**, and **as applied to claim 7 above**, Moles et al., as modified by Carroll, clearly show and disclose the claimed invention except the details that comprise the build request generation.

In the same field of endeavor, Lipsit clearly shows and discloses a method and apparatus for programming a cellular telephone with activation parameters, reading on the claimed "build request," in which the cellular telephone to be programmed is connected to a computer via a communications interface. The computer determines the activation parameters based on the inputted programming information, and transmits the activation parameters to the telephone for storage in the cellular telephone memory. The user inputted programming information may include the cellular telephone type reading on the claimed "build request generation comprises selecting a handset manufacturer's model number," (abstract, column 2 lines 49-51 and 56-60).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine activation parameters by using the cellular telephone type, reading on the claimed "handset manufacturer's model number," taught by Lipsit in the system of Moles et al. in order to provide an efficient provisioning system for mobile stations.

Consider **claim 10**, and **as applied to claim 9 above**, the combination of Moles et al., as modified by Carroll, and Lipsit clearly show and disclose the claimed invention except that the build request generation comprises entering Service Provider Codes. The examiner takes official notice that it is well known in the art that Service Provider Codes could be used to generate a build request to provision a radiotelephone handset unit.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the Service Provider Codes to generate activation parameters, reading on the claimed "build request," in order to successfully implement the steps of the method associated with a provisioning system.

Consider **claim 11**, the combination of Moles et al., as modified by Carroll, and Lipsit disclose the claimed invention **as applied to claim 9 above**, and in addition, Carroll further discloses that provisioning information, including an authentication key, is transferred by the WUPD via a wireless interface, reading on the claimed "build request generation further comprises entering Authentication Keys," (abstract).

Consider **claim 12**, and **as applied to claim 7 above**, Moles et al., as modified by Carroll, clearly show and disclose the claimed invention except the details that comprise the data retrieval.

In the same field of endeavor, Lipsit clearly shows and discloses a method and apparatus for programming a cellular telephone with activation parameters,

reading on the claimed "build request," in which the cellular telephone to be programmed is connected to a computer via a communications interface. The computer determines the activation parameters based on the inputted programming information, and transmits the activation parameters to the telephone for storage in the cellular telephone memory. The user enters a cellular telephone type in the area **404** of the user interface **400**. A picture of the telephone selected by the user is displayed in area **408** of the user interface. When the user selects a telephone type the appropriate graphics file is accessed, reading on the claimed "data retrieval comprises displaying an image of the handset model," (abstract, figures 3A and 4, column 2 lines 56-60 and column 5 lines 40-65).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display a picture of a selected telephone type as taught by Lipsit in the system of Moles et al. in order to provide an efficient provisioning system for mobile stations.

Consider **claim 14**, and **as applied to claim 7 above**, Moles et al., as modified by Carroll, clearly show and disclose the claimed invention except inspecting memory storage of the mobile station, reading on the claimed "handset," to verify provisioning data.

In same field of endeavor, Lipsit clearly shows and discloses a method and apparatus for programming a cellular telephone with activation parameters, reading on the claimed "build request," in which the cellular telephone to be

programmed is connected to a computer via a communications interface. The computer determines the activation parameters based on the inputted programming information, and transmits the activation parameters to the telephone for storage in the cellular telephone memory. The computer determines if the programming was successful by determining if a valid ESN (electronic serial number) is read from the telephone, reading on the claimed "inspecting the memory storage of the handset to verify provisioning data integrity," (abstract, figure 3A, column 2 lines 56-60 and column 8 lines 18-21).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine if programming on the telephone was successful as taught by Lipsit in the system of Moles et al. in order to provide an efficient provisioning system for mobile stations.

Allowable Subject Matter

14. **Claims 18-20, 23-25 and 27-28** are allowed.
15. **Claims 13, 16 and 17** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Double Patenting

16. Applicant is advised that should **claims 10 and 11** be found allowable, **claims 21 and 22** will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaime M. Holliday whose telephone number is (571) 272-8618. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


RAFAEL PEREZ-GUTIERREZ
PRIMARY EXAMINER
10/3/05